

REMARKS

Claims 1-10, 14-19, and 21-25 are pending in the application.

Claims 23 and 25 have been rejected under 35 U.S.C. § 112, first paragraph, on the grounds that the claims cite to new matter not found within the patent as originally filed.

Claims 1-10, 14-19, 21, 22 and 24 have been explicitly rejected under 35 U.S.C. § 103(a).

The Examiner has not explicitly rejected claims 23 and 25 under § 103(a), nor provided grounds for such rejection. Accordingly, the Examiner is invited to confirm whether claims 23 and 25 are allowable over the prior art provided that the § 112, first paragraph, issues are addressed. If claims 23 and 25 are rejected under § 103(a), the Examiner is encouraged to show where the prior art teaches the limitations expressed in those claims.

Claim Rejections – 35 U.S.C. § 112

Claims 23 and 25 are rejected under 35 U.S.C. § 112, first paragraph, on the grounds that the claims cite to new matter not found within the patent as originally filed. The Examiner is incorrect with respect to claim 23, as FIG. 1 shows two light paths (path 24 and path 26). FIG. 1 also shows two patterning means, including a first, dynamic patterning means 48 and a second patterning means 28 shown by the wheel-like gobo including window 34, referred within the specification (page 2, line 19) as "patterning means." As for claim 25, the claim has been amended to place it in better form for Appeal by reciting a mirror under control of the steering means to reflect the new light pattern in the controllable direction. Such is supported within the specification.

Claim Rejections – 35 U.S.C. § 103

The Examiner has implicitly rejected all of the claims based on two of the prior art patents listed in the last Office Action, namely Faris, et al. (U.S. Patent No. 5,680,233) and Mueller, et al. (U.S. Patent No. 6,016,038). As stated above, claims 23 and 25 are not particularly cited as being rejected over the prior art, but we ask the Examiner to confirm.

More specifically, claims 1, 11-13, 18-19, 21-22 and 24 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Faris, et al. Claims 2-10 and 14-17 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Faris, et al., in view of Mueller, et al.

Claim 1 had been amended in the Response of June 3, 2004 to include the limitations of original claim 13 (with claims 11-13 consequently cancelled) that the steering means have two moveable axes – a first axis transverse to a mirror axis, and a second axis transverse to the mirror axis and the first axis. In maintaining the rejection of the claim under § 103(a), the Examiner completely ignores this limitation both in the primary rejection and in the Response to Arguments section of the Final Office Action. Faris does not include such a feature nor would it be advantageous or even advisable to include such a feature. The Examiner notes that, though Faris teaches a fixed mirror, "it

would have been obvious to one of ordinary skill in the art at the time of the invention to provide an image projection head which can be tilted." This requires a projection head that is movable in a single axis to presumably raise or lower the projected image higher or lower onto the projection screen. Horizontal control is already achieved by rotating the overhead projector itself. There are well recognized keystone problems with this approach. Mirror tilting in a second axes with an overhead projector complicates the issue even further. Accordingly, there is no need for the mirror to be adjusted in any other direction and Faris saw fit to not even include a single direction adjustment means. Two axes of adjustment in an overhead projector head such as Faris are redundant, disadvantageous, and not suggested by the art of record. Accordingly, claim 1 should be in condition for allowance.

The rejection cited in the Final Office Action simply states that "[a]lthough Faris does not disclose a steering means, it is well known overhead projectors have image projection head (99) which is tiltable so that the light pattern can be directed in a desired direction including first and second directions." This type of common knowledge rejection is not sanctioned by the Federal Circuit Court of Appeals reviewing such cases. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). Additionally, the recitation of "first and second directions" misses the point entirely of the limitation language within the claims. That is, "first and second directions" are different than a mirror having two moveable axis transverse to one another. The Examiner is invited to allow the claim on its own merits, or in the alternative, show explicitly within the prior art where such limitation is suggested for combination with the other limitations of claim 1.

Claim 18 has been amended to incorporate the added limitation that the mirror is tilted across two axes. Faris does not include such a feature nor would it be desirable to have such a feature as demonstrated above. Accordingly, claim 18 should be in condition for allowance. Claims 19 and 21-22 depend on claim 1 and should also be in condition for allowance for at least the same reasons.

Claims 2-9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faris et al. and Mueller et al. Claims 2-9 and 10 depend on claim 1 and should be in condition for allowance for at least the same reasons. That is, *inter alia*, there is no suggestion of a mirror with two transverse axes of rotation.

Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faris et al. in view of Mueller et al.

Applicants traverse these rejections on the grounds that, *inter alia*, it would not be obvious to combine the color light source of Mueller with the projector apparatus of Faris. Mueller discloses using LEDs of various colors as a light source. However, it would not be obvious to use a colored light source (other than white) with Faris systems. In Faris, the image is a slide or transparency which may already include color information thereon. If the slide/transparency is a picture, colored backlighting would degrade the quality of the image on the slide and result in an imperfect projection. For this reason, all projectors use white light. Additionally, the embodiment shown in Faris FIG. 12A

discloses the panels used as a backlight for slides/transparencies. Therefore, it would not be obvious to combine the LEDs of Mueller into a color-control array because Faris would only require, and in fact only effectively operate with, white light.

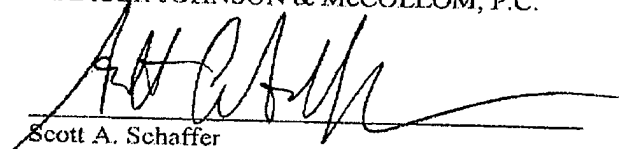
Claim 23 is based on claim 1 but with the amended requirement of having two patterning means. Faris and other references only use one patterning means (*i.e.*, the transparency laid upon the projecting surface). Accordingly, claim 23 should be in condition for allowance.

Claim 24 depends on claim 1 but with the additional requirement that the steering means be adjustable during formation of a new light pattern. Faris and other references only pattern a stationary image. Accordingly, claim 24 should be in condition for allowance. Claim 25 depends on claim 24 with the added requirement that the mirror be controllable under the steering means and should also be in condition for allowance.

For the foregoing reasons, reconsideration and allowance of claims 1-10, 14-19, and 21-25 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Scott A. Schaffer
Reg. No. 38,610

MARGER JOHNSON & McCOLLOM, P.C.
1030 SW Morrison Street
Portland, OR 97205
503-222-3613
Customer No. 20575